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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,986	06/25/2003	Anthony J. Wasilewski	A-9233	3781

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SCIENTIFIC-ATLANTA, INC.  
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EXAMINER

CHAI, LONGBIT

ART UNIT	PAPER NUMBER
	2131

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/602,986	WASILEWSKI ET AL.	
	Examiner Longbit Chai	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 25 June 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 June 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/25/2003</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Priority***

1. Applicant's claims for benefit of Continuation-in-part of Application priority date under 35 U.S.C. 120 is acknowledged.

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The application is filed on 6/25/2003 but all of the claims 1 – 27 are not solely directed to originally supported subject matter present in the parent application (for example, related to partially-encrypted data stream).

However, the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

As a result, all of the claims 1 – 27 will not receive benefit of the filing date of the earlier file application, and thereby the effective filing date for the subject matter defined in the pending claims in this application remains 6/25/2003.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 13 and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of copending Application No. 10/602,988. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 13 and 23 of the instant application are envisioned by copending application claims in that claims 1 and 7 of the copending application contain all the limitations of claims of the instant

application. Claims 1, 13 and 23 of the instant application therefore are not patentably distinct from the earlier copending application claims and as such are unpatentable for obvious-type double patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Unger (PN: 2003/0026423).

As per claim 1, Unger teaches a method for providing an instance in a conditional access system, the method comprising the steps of:

selecting a digital bit stream from a plurality of digital bit streams (Unger: Para [0055] – [0068] & Table 1 and Figure 6);  
encrypting the selected digital bit stream according to a first level encryption method to provide an encrypted instance (Unger: Table 1 and Figure 6 / E318);

combining the encrypted instance with the plurality of digital bit streams to provide a partially-encrypted bit stream (Unger: Table 1 and Figure 6 / E322 & Para [0053] – [0058]); and

transmitting the partially-encrypted bit stream (Unger: Figure 6).

As per claim 2, 4, 14, 15 and 25, Unger teaches each of the plurality of digital bit streams includes a packet identifier, and wherein the selecting step selects the digital bit stream by identifying a predetermined packet identifier (Unger: Table 1 and Para [0010] & [0047]).

As per claim 3, Unger teaches all of the selected digital bit stream is encrypted according to the first level encryption method (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

As per claim 5, Unger teaches a portion of the selected digital bit stream is encrypted, wherein the encrypted portion and an unencrypted portion of the selected digital stream are combined with the plurality of digital bit streams (Unger: Table 1 and Figure 6 / E322 & Para [0053] – [0058]).

As per claim 6, Unger teaches the selected digital bit stream is a program (Unger: Table 1 and Para [0055]).

As per claim 7, Unger teaches the selected digital bit stream is an elementary digital bit stream (Unger: Table 1, Para [0087], [0109] and [0010]).

As per claim 8, Unger teaches selecting more than one digital bit stream from the plurality of digital bit streams, wherein the more than one digital bit stream is identified by predetermined packet identifiers (Unger: Table 1, Para [0087], [0109] and [0010]).

As per claim 9, Unger teaches each of the more than one digital bit stream includes a distinct packet identifier, wherein the selecting step selects the more than one digital bit stream by identifying at least one of the distinct packet identifiers (Unger: Table 1, Para [0087], [0109] and [0010]).

As per claim 10, Unger teaches a portion of each of the more than one digital bit stream is encrypted according to the first level encryption method (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

As per claim 11, Unger teaches all of the more than one digital bit stream is encrypted according to the first level encryption method (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

As per claim 12, Unger teaches at least one of a portion of each of the more than one digital bit stream and all of the more than one digital bit stream is encrypted

according to the first level encryption method (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

As per claim 13, Unger teaches a method for providing a program in a conditional access system, the method comprising the steps of:

selecting a program from a transport stream (Unger: Para [0055] – [0068] & Table 1 and Figure 6);  
encrypting a portion of the program (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]);  
combining the encrypted portion and the remaining portion of the program with the transport stream (Unger: Table 1 and Figure 6 / E322 & Para [0053] – [0058]); and  
transmitting the combined stream (Unger: Figure 6).

As per claim 16, Unger teaches the encrypted portion includes at least one of the plurality of packets associated with the video stream (Unger: Table 1, Para [0087], [0109] and [0010]).

As per claim 17, Unger teaches the at least one of the plurality of packets is selected by the packet identifier indicative of the video stream (Unger: Table 1, Para [0087], [0109] and [0010]).

As per claim 18, Unger teaches the encrypted portion includes at least one of the plurality of packets associated with the audio stream (Unger: Table 1, Para [0087], [0109] and [0010]).

As per claim 19, Unger teaches the at least one of the plurality of packets is selected by the packet identifier indicative of the audio stream (Unger: Table 1, Para [0087], [0109] and [0010]).

As per claim 20, Unger teaches the encrypted portion includes at least one of the plurality of packets associated with the data stream (Unger: Para [0109] and [0010]).

As per claim 21, Unger teaches the at least one of the plurality of packets is selected by the packet identifier indicative of the data stream (Unger: Para [0109] and [0010]).

As per claim 22, Unger teaches the encrypted portion includes at least one of the plurality of packets associated with at least one of the video stream, the audio stream, and the data stream (Unger: Table 1, Para [0087], [0109] and [0010]).

As per claim 23, Unger teaches method for providing a program in a conditional access system, the method comprising the steps of:

selecting a digital bit stream from a plurality of digital bit streams (Unger: Para [0055] – [0068] & Table 1 and Figure 6);

encrypting a percentage of the selected digital bit stream (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]);

combining the encrypted percentage, the unencrypted percentage, and the plurality of digital bit streams to provide a partially encrypted bit stream (Unger: Table 1 and Figure 6 / E322 & Para [0053] – [0058]); and

transmitting the partially encrypted bit stream (Unger: Figure 6).

As per claim 24, Unger teaches the encrypted percentage comprises at least one of a video packet, an audio packet, and a data packet (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

As per claim 26, Unger teaches the percentage varies over time (Unger: Para [0077] and [0078]).

As per claim 27, Unger teaches the percentage is selected based on content (Unger: Table 2 and Para [0074]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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